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AKERMAN SENTERFITT			EXAMINER	
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WEST PALM BEACH, FL 33402-3188				
		ART UNIT	PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,313

Applicant(s)

THUERK, KEITH A.

Examiner

WILLIAM J. GOODCHILD

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 34-35 can be considered to be software in accordance with applicants specification, (page 14, paragraph 46, "The present invention also can be embedded in a computer program product, which comprises all the features enabling the implementation of the methods described herein, and which when loaded in a computer system is able to carry out these methods."). In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 6-20 and 24-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Landon, Deb, Del Valle, Sergio, Piza, Jazmin, Rush, Leif, "Deploying Lotus Sametime on the eserver iSeries Server", Redbooks, June 2002, (hereinafter Lotus Sametime).

In reference to claims 1, 19 and 34, Lotus Sametime teaches a method / system comprising: providing a collaborative computing system comprising at least one instant messaging client, (page 2, 1.1, page 65, figure 3-46, Sametime Connect for the desktop, Exchange messages with AOL Instant Messenger users); initializing said instant message client within a graphical user interface of said collaborative computing system, (page 136, 5.2.1); specifying at least one search limitation, said search limitation preventing users other than users belonging to a predetermined class of users from accessing data records pertaining to one or more predetermined online entities and from receiving data indicating an online presence o one or more predetermined online entities [page 6, 1.2.9, Security, access is restricted via Access control lists for users or groups access to a database]; receiving a search initializing action from said graphical user interface, (page 201, Creating a buddy list and group); responsive to said receiving step, presenting search input fields within said graphical user interface, (page 201, figure 6-7); receiving input via said input fields that specifies a search pattern, (page 201, figure 6-7 and Creating a buddy list and group); subject to said at least one search limitation, searching at least one record source for online entities that satisfy said

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search pattern, (page 201, step 2-3); and displaying a search result from said searching step within said graphical user interface, (page 201, step 2).

In reference to claims 2 and 20, Lotus Sametime teaches the method / system of claims 1 and 19 wherein: said collaborative computing system is a Lotus Sametime (TM) type system, (page 15).

In reference to claims 6 and 24, Lotus Sametime teaches the method / system of claims 1 and 19 further comprising: establishing a plurality of user specific search patterns; and recording said search patterns so that said search patterns can be retrieved at a later time, (page 126, 1st paragraph and figure 4-22, Search filters).

In reference to claims 7 and 25, Lotus Sametime teaches the method / system of claims 1 and 19 wherein: said record source comprises a first database that is a record source specifying at least one online entity and a second database having a data field, wherein said data field specifies an attribute relating to said online entity that is not specified within said first database, said searching step further comprising the steps of: establishing a query that includes said data field; and searching for at least one online entity using said query, (page 126, figure 4-22, field search filter for resolving person or groups and table 4-5).

In reference to claims 8 and 26, Lotus Sametime teaches the method / system of claims 1 and 19 further comprising: specifying a plurality of record sources, each of which specifies at least one online entity, wherein said searching step further comprises searching said plurality of record sources for online entities that satisfy said search pattern, (page 120, table 4-2, Description of Field "Host Name or IP address of the LDAP server").

In reference to claims 9 and 27, Lotus Sametime teaches the method / system of claims 8 and 26 further comprising: establishing at least one search preference that is used when performing said searching step, wherein said search result is based at least in part upon said search preference, (page 122, table 4-3, Field 'People').

In reference to claims 10 and 28, Lotus Sametime teaches the method / system of claims 8 and 26 further comprising: establishing an order in which said record sources are accessed during said searching step, (page 120, table 4-2, Field "Position of this server in the search order").

In reference to claims 11 and 29, Lotus Sametime teaches the method / system of claims 1 and 19 further comprising: directly executing at least one software-enhanced communication involving said online entity and a user of said graphical user interface using said search result, (page 9, 1.3.3, 4th and 5th paragraphs).

In reference to claims 12, 30 and 35, Lotus Sametime teaches a method / system comprising: specifying at least one search limitation, said search limitation preventing users other than users belonging to a predetermined class of users from accessing data records pertaining to one or more predetermined online entities and from receiving data indicating an online presence of one or more predetermined online entities [page 6, 1.2.9, Security, access is restricted via Access control lists for users or groups access to a database]; receiving a user specified search pattern, (page 125, #'s 11-12); searching a point of presence database for online entities having access to a collaboration software application which satisfy said search pattern, (page 3, 1.2.3, page 126, figure 4-22 and table 4-5); presenting a list of said resulting online entities, (page 126, 1st paragraph); receiving a selection of at least one of said resulting online entities contained within said list, (page 126, 1st paragraph); and establishing a software-enhanced communication session between said user and said selected online entity, (page 3, 1.2.3, page 126, figure 4-22 and table 4-5).

In reference to claims 13 and 31, Lotus Sametime teaches the method / system of claims 12 and 30 further comprising: displaying a graphical user interface for an instant messaging component of said collaboration software application, (page 151, figure 5-28), wherein said graphical user interface provides a user selectable search option; receiving a user selection for said search option, (page 201); and responsively presenting search input fields within said graphical user interface, wherein said search pattern is based upon data input into said search input fields, (page 201, input box).

In reference to claims 14 and 32, Lotus Sametime teaches the method / system of claims 13 and 31 wherein: said software-enhanced communication session includes a type of communication other than instant messaging, (page 150, 5.5 – page 151).

In reference to claims 15 and 33, Lotus Sametime teaches the method / system of claims 12 and 30 wherein: said collaboration software application is a Lotus Sametime (TM) type application, (page 15).

In reference to claim 16, Lotus Sametime teaches a method comprising: a collaboration server configured to coordinate collaboration operations between a plurality of geographically disperse software components, (page 9, 1.3.3, 4th paragraph); and at least one client side collaboration application that includes a search engine, said search engine configured to query said collaboration software system for online entities, (page 121, figures 4-19 and 4-20), wherein said client side collaboration application contains a graphical user interface permitting user customization of said search engine, (page 121, figures 4-19 and 4-20), and wherein said search engine is configured to specify at least one search limitation, said search limitation preventing users other than users belonging to a predetermined class of users from accessing data records pertaining to one or more predetermined online entities and from receiving data indicating an online presence of one or more predetermined online entities [page 6, 1.2.9, Security, access is restricted via Access control lists for users or groups access to a database].

In reference to claim 17, Lotus Sametime teaches the method / system of claim 16 wherein: said graphical user interface comprises an instant messenger view and a search view, (page 201, figure 6-7).

In reference to claim 18, Lotus Sametime teaches the method / system of claim 17 wherein: said search view is directly initiated from said instant messenger view, and wherein said search view utilizes said search engine, (page 201, figure 6-7 and item 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 and 21-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Lotus Sametime as applied to claims 1 and 19 above, and further in view of Berger et al., (US Publication No. 2004/0267887), (hereinafter Berger).

Regarding claims 3 and 21, Lotus Sametime does not specifically disclose said search initializing action comprises at most two user inputs. However, Berger in the same field of endeavor, discloses an option for searching for 'additional contact options' [Berger, paragraph 33]. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to incorporate search options with default settings in order to reduce the number of required entries by the user.

Regarding claims 4 and 22, Lotus Sametime-Berger further discloses displaying a menu option within said graphical user interface for said instant message client, wherein said menu option is configured to initiate said search view [Berger, paragraph 33].

Regarding claims 5 and 23, Lotus Sametime-Berger further discloses providing a keyboard combination to initiate said search view, whereby said keyboard combination is a hot-key combination [Berger, paragraph 35, 'or selecting a designated key from the data processing device's keyboard']l.

Response to Arguments

5. Applicant's arguments filed 10/23/2007 have been fully considered but they are not persuasive.

A - Regarding 101 rejection of claims 34-35, applicant argues "In a related vein, independent Claims 34 and 35 both recite physical features in statutorily-recognized 'means-for' language."

A. 'means-for' language encompasses the entire specification and in accordance with applicants specification page 13, paragraph 45, "The present invention can be realized in hardware, **software**, or a combination of hardware and software.", and page 14, paragraph 46, "The present invention also can be **embedded in a computer**

program product, which comprises all the features enabling the implementation of the methods described herein, and which when loaded in a computer system is able to carry out these methods.”. During patent examination and prosecution, claims must be given their broadest reasonable interpretation.

B – Applicant argues “Specifically, the references fail to teach, or even suggest, specifying at least one search limitation that prevents users, other than users belonging to a predetermined class of users, from accessing data records pertaining to one or more predetermined online entities...”, and “Similarly, neither of the cited references teaches or suggests specifying at least one search limitation that prevents users, other than users belonging to a predetermined class of users, from receiving data indicating an online presence of one or more predetermined online entities...”.

B. A search limitation that allows or denies access to specific users, groups of users is set up and controlled within the Access Control Lists (ACLs) [Lotus Sametime, page 6, under 1.2.9, Security, unauthorized users will not be allowed access].

6. Applicant’s arguments, see Remarks/Arguments, filed 10/23/2007, with respect to 101 for claims 16-33 have been fully considered and are persuasive. The 101 rejection of claims 16-33 have been withdrawn.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. GOODCHILD whose telephone number is (571)270-1589. The examiner can normally be reached on Monday - Friday / 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WJG
01/03/2008

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145